PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Eric J. Hansen and Jesse J. Williams		
For:	EXTRACTION CLEANING WITH OXIDIZING AGENT		
Serial No.:	09/589,973	Examiner: Derrick G. Hamlin	
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Sir:

RESPONSE TO OFFICE ACTION

This paper is in response to the Office Action mailed August 14, 2002.

In the Office Action, claims 1-28, all of the claims in this application, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Miracle et al. U.S. Patent No. 5,576,282 and further in view of Ligman U.S. Patent No. 5,555,595 or Sham U.S. Patent No. 5,386,612. This rejection is respectfully traversed.

The Miracle et al. '282 patent discloses a bleach composition comprising a peroxygen source and a bleach booster selected from the group consisting of zwitterionic imines and anionic imine polyions having a net negative charge to increase bleaching effectiveness in lower temperature solutions. The bleach boosters are said to be ideally suited for inclusion into bleaching compositions including those with detersive surfactants and enzymes. The peroxygen source can include hydrogen peroxide, inorganic peroxohydrates, organic peroxohydrates and

organic peroxyacids including peroxycarboxylic acids. Peroxyhydrates include perborates, percarbonates, perphosphates, and persilicates. Bleach activators such as TAED can also be used with the peroxide source. The Miracle et al. '282 compositions are said to be useful in laundry additive compositions. In addition, Miracle et al. discloses a method of laundering a fabric employing the bleach boosters of the invention. All examples relate to laundry detergent compositions. All claims in the Miracle et al. '282 reference relate to bleach compositions, a method of laundering fabric and a laundry additive product.

Miracle et al. incidentally discloses a virtual laundry list of possible uses for their *bleach compositions*, including "car and carpet shampoos." This disclosure is without any further support by way of example or otherwise.

The Ligman '595 patent discloses a carpet cleaner which includes an electric heater for heating a cleaning solution in a solution tank that is sprayed onto a floor. The carpet cleaner operates in a manner of a conventional extraction carpet cleaner well known in the carpet cleaning art.

The Sham '612 patent discloses a portable steam vacuum cleaner wherein water or cleaning solution is heated in an electric heater to produce steam. An extraction system removes soiled water from a surface to be cleaned. The Sham device is preferably used for generating steam for delivery to a flat surface, such as a window, floor or table to be cleaned. Water or a cleaning solution such as, for example, soapy water can be used in the reservoir of the Sham cleaner.

The rejection appears to hold that the claims are unpatentable over Miracle et al. '282, alone, and further in view of either Ligman '595 or Sham '612. The Examiner acknowledges that the Miracle et al. '282 patent does not disclose the concept of Applicants' invention as defined in claim 1:

> The primary reference is deficient, as it fails to teach a carpet cleaning machine employing the cleaning solution disclosed. The primary reference does indicate that the composition is applicable to many types of cleaning operations, such as shampooing carpets. Therefore, one would be motivated to employ one of the following carpet cleaning machines to clean a carpet with the carpet shampoo of the reference. (Office Action, p. 3)

It is quite clear that the Miracle et al. '282 patent does not disclose a method for cleaning an upholstery or carpet surface in which a fluid carpet or upholstery cleaning solution is dispensed onto the upholstery or carpet surface to be cleaned and the cleaning solution is recovered from the surface with suction. For this reason, claim 1 and dependent claims 2-28, patentably define over the Miracle et al. '282 patent.

Contrary to the Examiner's representation, there is no hint or suggestion in Miracle et al. '282 of the use of a carpet shampoo in a method according to the invention. The Miracle et al. '282 patent is principally related to laundry detergents. Whereas the Miracle et al. '282 patent incidentally discloses that the disclosed bleach composition can be used in carpet shampoos, it does not disclose that such shampoos can be used in the conventional extractors as represented by the examiner. Nor does the Miracle et al. '282 patent disclose that the bleach boosters can be combined with a carpet cleaning composition that are then applied to a floor surface and then recovered from the floor surface by suction. Applicants believe that the bleach compositions of Miracle would not in fact be useful in carpet shampoos despite the incidental disclosure in the Miracle et al. '282 reference because they would tend to lighten the carpet or otherwise strip color from a carpet. This result would be highly undesirable for any carpet shampoo. Applicants' method claims do not recite a bleach booster.

The alleged combination of Miracle et al. '282 with either Ligman '595 or Sham '612 is traversed. There is no basis for making the alleged combination.

The alleged combination is not obvious because bleach compositions would not be suitable in carpet cleaning methods. Bleach compositions would tend to lighten carpets and thus would not be used in cleaning solutions in the Ligman '595 or Sham '612 references. The Miracle et al. '282 bleaching compositions are used in washing machines wherein the fabrics, although color fast, need brightening. The process of washing clothing treats the clothing uniformly and thus the brightening is necessarily uniform in the clothing. Carpet extractors, as disclosed in the Ligman '595 and Sham '612 references would not necessarily be used in a process for cleaning carpets uniformly. One might use the Ligman '595 or Sham '612 extractors to clean a portion of a carpet. That cleaned portion might be lightened considerably compared to

adjacent portions of the carpet if the cleaning composition included a Miracle et al. '282 bleaching composition. That would be an unfortunate result for a homeowner. Even when an entire carpet is cleaned with an extractor, such as disclosed in the Ligman '595 or Sham '612 references, the cleaning process may itself be non-uniform depending on the skill of the user of the equipment. Uneven cleaning of the carpet with a cleaning solution that includes a Miracle et al. '282 bleaching composition may result is blotches of brightened carpet. Needless to say, a homeowner would be very unhappy with the carpet cleaner manufacturer. For these reasons, the alleged combination of Miracle et al. '282 with either Ligman '595 or Sham '612 is not obvious as alleged by the Examiner.

Further, it should be pointed out that the disclosure of the use of the bleaching compositions in a carpet shampoo in the Miracle et al. '282 reference is an incidental disclosure with a number of other potential uses. There is no support in the Miracle et al. '282 reference for the use of the Miracle et al. '282 bleaching composition in a carpet shampoo. There is no other disclosure of a carpet cleaning solution that incorporates the Miracle et al. '282 bleaching composition in the Miracle et al. '282 reference. No examples in the Miracle et al. '282 reference disclose a carpet cleaning composition or process. No claims in the Miracle et al. '282 reference are directed to a carpet cleaning composition or process. The Miracle et al. '282 reference discloses no test conducted on cleaning carpets with the Miracle et al. '282 bleaching composition in a carpet cleaning solution. The nature of the disclosure must be taken into consideration when considering the disclosure in the Miracle et al. '282 reference under 35 U.S.C. § 103 (a).

Other than the incidental disclosure in the Miracle et al. '282 reference, there is no suggestion of the alleged combination of Miracle et al. '282 with either Ligman '595 or Sham '612. The incidental disclosure in the Miracle et al. '282 reference is not a credible suggestion of the use of the Miracle et al. '282 bleaching compositions in the extractor of Ligman '595 or Sham '612. Certainly, there is no disclosure in either of the Ligman '595 or Sham '612 reference for the use of any bleaching composition in the cleaning solutions used in these extractors.

Thus, there is no credible support for the alleged combination of references in any of the references. The Examiner is respectfully requested to consider the recent decisions of the United States Court of Appeals for the Federal Circuit with respect to the issue of obviousness. In particular, the Examiner's attention is directed to Ecolochem, Inc. v. Southern California Edison Co., Case 99-1043 decided September 7, 2000, 227 F.3d. 1361; 56 USPQ2d 1065, (http://www.ll.georgetown.edu/Fed-Ct/Circuit/fed/opinions/99-1043.html) at 1371-1372 in which the Court stated:

> Our case law makes clear that the best defenses against hindsight-based obviousness analysis is *the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.* See Demibiczak, 174 F.3d at 999, 50 USPQ2d at 1617. "*Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essences of hindsight.*" Id.
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> "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Roufet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing In re Geiger, 815 F.2d 686, 688 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)). The same principle applies to invalidation. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Although the suggestion to combine references may flow from the nature of the problem, see Pro-Mold & Tool Co. v. Great lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), *"[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness,"* Monarch Kitting Mach. Corp. v. Sulzer Morat GMbh, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998). Therefore, "[w]hen determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040 1042 (Fed. Cir. 1992) (quoting Lindemann, 730 F.2d at 1462, 221 USPQ at 488). (Emphasis added.)

The Examiner has erred in attempting to use the Applicants' disclosure as a blueprint for hindsight-based arguments and has not comported with the standards of the United States Court of Appeals for the Federal Circuit.

The Examiner's attention is also directed to In re Sang-Su Lee, 00-1158, decided January 18, 2002, 277 F.3d 1338; 61 USPQ2d (BNA) 1430 (http://www.ll.georgetown.edu/Fed-Ct/Circuit/fed/opinions/00-1158.html) at pages 1342-1344 which holds as follows:

> As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. § 103 must be based on evidence comprehended by the language of that section." In re Graselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deer Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).
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> "The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp., v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("'teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).
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> The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in

the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of the ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

Like the Examiner in In re Sang-Su Lee, the Examiner in this application has not adequately addressed the issue of motivation to combine the references. Simply pointing out Applicants' disclosed solution to a problem or some speculative beneficial result of the combination does not meet the requirement of motivation to combine the references.

The Examiner's conclusory statement of obviousness with the expected results does not satisfy the standard of 35 U.S.C. § 103(a) as articulated by the United States Board of Appeals for the Federal Circuit in the *Ecolochem* and the *Sang-Su Lee* cases cited above. Thus, the Examiner's alleged combination of either Ligman '595 or Sham '612 with Miracle et al. '282 is inappropriate.

Even if the alleged combination were to be made, however untenably, it would not meet applicants' claimed invention. The alleged combination of references would at best teach the use of the Miracle et al. '282 bleaching composition in a carpet cleaning solution that is used in the extractors of either of the Ligman '595 or Sham '612 references. The claimed invention relates to a method of cleaning an upholstery or carpet surface including the step of admixing an oxidizing agent with the cleaning solution prior to the step of dispensing the cleaning solution onto the upholstery or carpet surface. This step is not disclosed in the alleged combination of references.

Further, claims 8, 14 and 18 are dependent on claim 1 and call for the admixture to be mixed with heated air to heat the admixture and the step of heating the air before the step of mixing the admixture with heated air. This concept is not disclosed in the alleged combination of references.

Still further, claims 11, 17 and 21 depend from claim 1 and further call for the step of heating the cleaning solution before the admixing step to heat the admixture. This concept is not disclosed in the alleged combination of references.

In view of the foregoing, it is apparent that claims 1-28 are patentable over the alleged combination of the Miracle et al. '282 reference, either alone or in combination with Sham '612 or Ligman '595. Withdrawal of the rejection of claims 1-28 is requested.

In view of the foregoing remarks and amendments it is submitted that all of the claims in the application are allowable. Early notification of allowability is respectfully requested.

Respectfully submitted,

Eric J. Hansen and Jesse J. Williams

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By: _____

John E. McGarry, Reg. No. 22,360
McGARRY BAIR LLP
171 Monroe Avenue, NW, Suite 600
Grand Rapids, Michigan 49503
616-742-3500

G0068084